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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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NEW YORK, NY 100362711

EXAMINER

ZIRKER, DANIEL R

| ART UNIT | PAPER NUMBER |
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1771

3

DATE MAILED: 04/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-44 is/are pending in the application.
Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-44 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit 1771

1. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3-12 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, in claims 3 and 4, release "tape" should be --liner--. In claims 5 and 7 it is suggested to put --further-- before "comprises". Additionally, the Examiner makes the observation that in claim 1, line 4 it is suggested to change "or" to --and/or-- since it is believed that the embodiment of claim 2 is also desirably encompassed by the generic claim. Also, it is further noted that in claim 24 the Examiner questions whether or not "a polyamide" is a "tackifier" since it is believed that few, if any polyamides qualify as tackifiers.

3. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art

Art Unit 1771

to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Nienaber et al., or Narayanan, each taken individually for claims 1-43, or in view of either Franey or McCarty et al. for claims 1-44. Each of the primary references discloses (note particularly Nienaber et al., a commonly assigned patent having a common co-inventor, the Abstract, column 1 lines 8-27, column 2 lines 27-56, column 3 lines 22-40, column 4 lines 46-43, column 5 lines 1-14, lines 51-58, column 6 lines 42-58, the Examples, claim 1; Narayanan, the Abstract, column 1 lines 9-21, column 2 lines 18-35, lines 46-67, Examples 1 and 2) substantial anticipations of at least applicants' broad independent article claim except for the product-by-process limitation that the masking layer or the pressure sensitive adhesive layer (or, it is presumed, both) are radiation cured. That is, each of the references discloses correction tapes having a release liner having coated thereon a masking layer which has on its opposing outer surface a pressure sensitive adhesive layer. Additionally, such elements which are found in applicants' dependent claims as the presence of pigments like titanium dioxide, bleed inhibitors, the presence of "reactive monomers" such as vinyl, acrylates, methacrylate, vinyl ether and epoxy are either expressly^{or inherently} disclosed or^{are} clearly

Art Unit 1771

believed to be well within the ordinary skill of the art. Although neither of the references discloses such well known photochemistry additives such as photoinitiators, these are also believed to be well within the ordinary skill of the art. As to the aforementioned product-by-process limitation requiring radiation curing of at least one of the masking layer and pressure sensitive adhesive layer, it is noted that such a process difference has not been shown to result in a patentably distinct article, and also with respect to Narayanan applicants' specification (page 2, lines 1-6) appears to admit that the only difference is that its process of making may be more expensive and complex. Additionally, the Examiner further believes that radiation curing is quite well known to one of ordinary skill in this technically sophisticated art. Alternatively, each of the secondary references discloses (note particularly Franey, the Abstract, column 1 lines 7-18, column 2 lines 3-28, column 6, lines 14-26; McCarty et al., the Abstract, column 4, lines 15-34, claim 1) as applicants appear to admit (specification, page 2 lines 12-25) that radiation curing for such elements as the pressure sensitive adhesive layer is both highly desirable and also can eliminate such problems as the usage of solvents and their associated handling and pollution problems (Franey, the Abstract). Additionally it is further noted that adhesion properties can be controlled to arrive at a coating composition

Art Unit 1771

having the desired degree of adhesion to the substrate to be coated (McCarty et al., Abstract) as can the properties of the masking layer. Accordingly, one of ordinary skill, motivated by an expectation of an improved, environmentally friendly, and industrially desirable process would have more than ample motivation to incorporate the radiation curing techniques of the secondary references into each of the primary reference articles and thereby either form, or clearly render obvious the claimed genus of articles. With respect to the method claim 44, the relied upon combinations clearly disclose or render obvious the process step of radiation curing. Additionally, with respect to those dependent claims that contain limitations such as the application of layers as a "hot melt" and also of layers possessing certain viscosities are product-by-process limitations not as yet shown to be patentably significant with respect to the formed genus of articles. Finally, such parameters as layer thicknesses of each of the various layers of the correction tape are each believed to be, if not expressly or inherently disclosed, obvious modifications to one of ordinary skill, in the absence of unexpected results.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also Katsuro et al. and Sugibuchi.

Serial No. 10/071,497

-6-

Art Unit 1771

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

April 2, 2003

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP ~~1300~~
1700

Daniel Zirker